



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,298	06/02/2005	Tomohisa Tenra	043890-0746	8367
20279 7590 12/17/2009 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
THOMAS, ALEXANDER S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
12/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,298

**Applicant(s)**

TENRA ET AL.

**Examiner**

Alexander Thomas

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-7, 15-17 and 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14, 18, 19 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. Claims 11, 13, 14, 18 and 27 stand rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese patent document 10-110,887 Tanimoto for the reasons of record. Applicant's arguments have been considered but are not deemed persuasive. The new language in claim 27 does not distinguish over the reference because wherever the first and second enveloping members in the reference are adhered to each other they have been adhered by thermal welding, in other words by heating and fusing, and thus will have the same structure as the claimed product. Applicant argues that "the configuration recited in amended claim 27 maintains that all portions of the core member and the enveloping members are heated and fused". However, this is not true because claim 27 does not require that the core member be heated or fused to any other layer. Concerning the arguments regarding the shape of the "border region" as defined in claim 27, the reference's product, as shown in Figure 1, has a border region shape that corresponds to the periphery of the core member. This was confirmed by the Board of Appeals in their decision dated 6/4/09, page 12, first and second full paragraphs. Applicant also argues that the reference "does not disclose that the entire portion of outer covering material(3) is heated and fused to the core material as now recited in claim 27". This is not convincing because claim 27 does not recite this limitation.

***Claim Rejections - 35 USC § 103***

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent document 10-110887 Tanimoto in view of the Japanese patent document 08-303686 Miyoshi for the reasons of record. Applicant's arguments have been considered but are not deemed persuasive for the same reasons as set forth above in the rejection under 35 USC 102. Applicant also argues that at least part of the core merely adheres to the outer covering material and is not heated and sealed. This is not convincing of patentability for two reasons. First, Figure 1 of Tanimoto shows three core materials 2, the center core material 2 has a heated sealed portion that will be around all of its sides, and thus, reads on the instant claim 27 structure. Second, the phrase applicant uses in his arguments, namely "is not heated and sealed", is a process limitation and does not provide any structure that would distinguish over the films 3 on the outer edges of the left and right core materials 2 in Figure 1 in Tanimoto.

3. Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent document 10-110887 Tanimoto in view of Stroobants 6,322,743 for the reasons of record. Applicant's arguments have been considered but are not deemed persuasive for the same reasons as set forth above in the rejection under 35 USC 102. Applicant argues that there is no teaching or suggestion in Stroobants that the outer covering layers are heated and sealed in all portions and heated and fused to the insulating core. However, this is not convincing because Stroobants discloses simultaneously heating, pressing and sealing his entire panel (the panel is placed between parallel plates at column 2, lines 21-37) and specifically desires to remove the wrinkles from the portion of the outer layers that contact the core material. In the

process of Stroobants, the heat necessary to seal the outer layers together and remove the wrinkles of the outer layers will inherently soften the outer layers and fuse the outer layers to the core material. Thus, if this same procedure was used on the Tanimoto product to prevent the formation of wrinkles, the outer layers would be fused or bonded to the core layer as well as to themselves around the outer edges of the core layer.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent document 10-110,887 Tanimoto for the reasons of record. Applicant's arguments have been considered but are not deemed persuasive for the same reasons as set forth above in the rejection under 35 USC 102.

#### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Thomas whose telephone number is 571-272-1502. The examiner can normally be reached on 6:30-4:00 M-THUR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Thomas/  
Primary Examiner  
Art Unit 1794